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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/900,251	07/06/2001	Sven Brueckner	ERIO11302/03	5963

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EXAMINER

SINES, BRIAN J

ART UNIT	PAPER NUMBER
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1743

DATE MAILED: 01/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/900,251

Applicant(s)

BRUECKNER ET AL.

Examiner

Brian J. Sines

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 – 40, 47 and 48 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The disclosure does not satisfy the enablement requirement under 35 U.S.C. 112, first paragraph in consideration of the following factors:

- (1) the breadth of the claims;
- (2) the nature of the invention;
- (3) the state of the prior art;
- (4) the level of skill of one of ordinary skill in the art;
- (5) the level of predictability in the art;
- (6) the amount of direction provided by the inventor;
- (7) the existence of working examples; and
- (8) the quantity of experimentation needed to make or use the invention based upon the content of the disclosure. See *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988) (see MPEP § 2164.01(a)).

Regarding (1) the breadth of the claims, since the specification does not adequately disclose a specific pump software component, distance software agents, pheromone, walker software component, type of sensor system or control system, which would be correlated and organized to enable each of the elements to form a complete operative system, a person of ordinary skill in the art is not enabled to make and use the entire scope of the claimed invention without undue experimentation (see MPEP § 2164.08).

Regarding (2) the nature of the invention, which is intrinsically related to the state of the prior art, is the subject matter to which the invention pertains and the background required in determining the state of the prior art and level of skill of a person of ordinary skill in the art. The lack of prior art provides evidence to the high degree of unpredictability in the art. The specification fails to bridge the gap between the level of skill of one of ordinary skill in the art, as evidenced by the prior art, and the applicants claimed invention, in order for the claimed system to function properly. For example, it is unclear as to how the pump software components, walker software agents and distance software agents are cooperatively associated, which would enable the claimed system to operate properly (see MPEP § 2164.05(a)).

Regarding (3) the state of the prior art, the lack of prior art pertaining to the subject matter of the application provides evidence for the lack of predictability in the art. Therefore, since the state of the prior art refers to the level of skill of a person of ordinary skill in the art, the specification as filed lacks sufficient direction or guidance required to meet the enablement requirement (see MPEP § 2164.05(a)).

Regarding (4) the level of skill of one of ordinary skill in the art, which refers to the skill of those in the art in relation to the subject matter to which the claimed invention pertains,

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the specification is deemed not enabling to a person skilled in the art, since the specification fails to bridge the gap between the level of skill of one of ordinary skill in the art, as evidenced by the prior art, and the applicants claimed invention, in order for the claimed system to function properly (see MPEP § 2164.05(b)).

Regarding (5) the level of predictability in the art, due to the lack of knowledge in the state of the prior art pertaining to the nature of the invention, there is a high degree of unpredictability in the art (see MPEP § 2164.03).

Regarding (6) the amount of direction provided by the inventor, due to the lack of predictability in the prior art, the specification needs to provide more direction and guidance as to how to make and use the claimed invention. For example, it is unclear as to how the pump software components, distance software agents and walker software components are cooperatively associated, which would enable the claimed system to operate properly (see MPEP § 2164.03).

Regarding (7) the existence of working examples, the invention is not disclosed in such a manner that one skilled in the art would be able to practice the claimed invention without undue experimentation, since the art area is relatively unpredictable and undeveloped. For example, it is unclear as to what kind of control system or sensor system is utilized. The specification provides no guidance or working example as to what constitutes the pump software component recited in the claimed system. How does the distance software component deposit the pheromone? The specification provides no guidance or working example as to what constitutes a pheromone as recited in the claimed system. The specification provides no guidance or working example as to

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what constitutes a walker software component as recited in the claimed system (see MPEP § 2164.02).

Regarding (8) the quantity of experimentation needed to make or use the invention based upon the content of the disclosure, since the applicants specification does not provide adequate direction and guidance in the practicing of the claimed invention, and since the art area is relatively unpredictable and undeveloped, the invention would require an undue amount of experimentation (see MPEP § 2164.06).

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 47 and 48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 47 provides for the use of a multi-layer grid system to direct a walker through a multi-pheromone environment, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 47 and 48 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Response to Arguments

Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian J. Sines, whose telephone number is (571) 272-1263. The examiner can normally be reached on Monday - Friday (11:30 AM - 8 PM EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on (571) 272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Diana L. Smith". The signature is written in a cursive style with a large, looping "S" at the end.